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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/349,676 | 07/08/1999 | KRISTEN DIANE ONDECK | PHA-23.681 | 6934 |

7590 01/14/2003

Corporate Patent Counsel
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EXAMINER

JANVIER, JEAN D

| | |
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| ART UNIT | PAPER NUMBER |
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3622

DATE MAILED: 01/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/349,676

Applicant(s)

ONDECK, KRISTEN DIANE

Examiner

Jean D Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 16, 2002 has been entered and a Non-Final Office Action is submitted below.

Response To Arguments

Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

DETAILED ACTION

Specification

The title of the invention is not descriptive so as to help one having ordinary skill in the art understand the nature of the subject matter. A new title is required that is clearly indicative of the invention to which the claims are directed (See 37 C.F.R. 1.72).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 (by extension claims 1-9) is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Indeed there is no clear support for the newly added limitation "enabling the provider to determine **with the retailer** a customization procedure to be carried out after a sale of the product". The information provided on page 3 lines 3-6, for example, in the amendment of the specification (paper no. 11) only discloses that **the merchandise is enabled to be customized via the Internet, preferably according to specification from the retailer....** ", but does not show the steps of determining a customization procedure by provider in conjunction with the retailer.

However, having worked on this Application for several months, the Examiner has enough background or understanding of the subject matter to apply an art rejection.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-6 recite the limitation "the equipment". There is insufficient antecedent basis for this limitation in the independent claim1. For examination purpose, the Examiner assumes that the Applicant meant to refer to -- the electronic device--.

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Status of the claims

Claims 1-9 were originally presented for prosecution. After the Final Office Action on the merits, claim 1 was once again amended. Claims 1-9 are still pending in the Instant Application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Scroggie et al. (Scroggie hereinafter), WO 97/23838.

As per claim 1, Scroggie discloses an incentive distribution network or system for providing purchase incentive offers, such as electronic coupons, recipes, rebates, shopping aids, product samples, supermarket specials, etc. to qualified customers over the Internet. First of all, the customer logs into the system and fills out a registration form where he provides his demographic information including geographical location having a specific zip code and other postal code since the features of the present system are location-dependent. If it is determined by the system that the submitted zip code is a valid zip code, that is a zip associated with a retail store where an electronic coupon can be redeemed, then the system allows the customer to proceed to the main menu and browse among available purchase incentive offers. The system

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merges customer supplied-information 270 with other purchase incentive data 272 of fig. 12 and creates or customizes a printable graphical image of the purchase incentive 282 for transmission or delivery to the identified customer. In one alternate embodiment of the invention, the purchase incentive or electronic coupon is not directly transmitted to the customer instead the terms of the purchase incentive or coupon, for example, are transmitted electronically to a retail store 310 of fig. 13, located in the customer's geographical location or zip code, pre-selected by the said customer, who receives either a token 316 or an advisory message to present at the retail store 310 during a redemption process.

In a further embodiment of the invention, incentives may be customized or targeted to a specific customer based on the customer's purchase history (previous purchase) 502 collected at a retailer's store after the sale of one or more products and provided to a product manufacturer or distributor or System Administrator system, and wherein the purchase history data comprising at least one product sold at the retailer's and wherein after this customization, by the manufacturer or provider or distributor of the product in conjunction with the retailer, the incentives are transmitted to consumer's computer 510 via electronic mail or e-mail address stored in a consumer database 506 storing customer's registration information or via a personal web page (electronic device) in the computer network established for each consenting consumer wherein the personal web page or electronic device is used to display the customized incentives to the user or customer whenever he/she logs into the network and wherein the web page is also customized, by the manufacturer in association with the retailer, using among other things the purchase history 502 collected at the retailer's store. Here, it is to be understood that the customized web page or electronic device will display on the user computer targeted incentives

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created specifically for the user based on the user demographic data, purchase history data and most of all based on information specific to the retailer, such as the location of one of his stores in the user's geographical area (See abstract; page 10: 4 to page 11: 14; figs. 1-5, 11-18; page 22: 2 to page 23: 2).

As per claims 2-9, Scroggie discloses, in one embodiment of the invention, that incentives may be customized or targeted to a specific customer based on the customer's purchase history (previous purchase) 502 collected at a retailer's store after the sale of one or more products and provided to a product manufacturer or distributor or System Administrator system, and wherein the purchase history data comprising at least one product sold at the retailer's and wherein after this customization, by the manufacturer or provider or distributor of the product in conjunction with the retailer, the incentives are transmitted to consumer's computer 510 via electronic mail or e-mail address stored in a consumer database 506 storing customer's registration information or via a personal web page (electronic device) in the computer network established for each consenting consumer wherein the personal web page or electronic device is used to display the customized incentives to the user or customer whenever he/she logs into the network and wherein the web page is also customized, by the manufacturer in association with the retailer, using among other things the purchase history 502 collected at the retailer's store. Here, it is to be understood that the customized web page or electronic device will display on the user computer targeted incentives created specifically for the user based on the user demographic data, purchase history data and most of all based on information specific to the retailer, such as the location of one of his stores in the user's geographical area (See abstract;

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page 10: 4 to page 11: 14; figs. 1-5, 11-18; page 22: 2 to page 23: 2). Finally, the incentives, such as shopping aids, supermarket specials, retailer's offers, manufacturer's samples, sweepstakes, rebates, coupons, etc., are considered to be a form of advertisements for manufacturer's and retailer's products and wherein these incentives or product promotions or advertisements are downloaded by the user or customer in an interactive manner (page 6: 3-12; page 24: 3-6).

Conclusion

Although the following references were not officially used in the office action, they were considered as relevant prior art. Applicant is further directed to review these references.

US Patent 5, 649, 114 to Deaton discloses a patronage incentive system wherein a customer's transaction history is used to provide incentives or coupons, redeemable on specific products, to the customer.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113. Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-872-9327

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Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

Please provide support, that is page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

JDJ
01/10/03



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